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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,182	11/21/2001	Allan J. Heffron	71342	1223

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EXAMINER

GOETZ, JOHN S

ART UNIT PAPER NUMBER

3725

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,182

Applicant(s)

HEFFRON ET AL.

Examiner

John S. Goetz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-12 in Paper No. 9 is acknowledged. The traversal is on the grounds that grouping all the claims together would not be a burden on the examiner. This is not found persuasive because there is a prima facie burden on the examiner given the number of original claims and the divergent subject matter claimed.
2. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "wherein" followed by the phrase "guide surfaces on the rolling arm and the second rolling head that guide the second rolling head for movement toward and from the first rolling head." The word "wherein" suggests that the following phrases will include a clause including a subject and a verb (like the first and third phrases). Without a verb the phrase is vague, needlessly confusing and renders the claim indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-4, 6-8 and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hamada et al. (JP 11042560 A – hereinafter Hamada).

7. Hamada discloses a rolling apparatus, for rolling a workpiece rotatable about a rotational axis, comprising:

- i. a rolling arm (3);
- ii. an arm support (see stand 2 and link mechanism connection arm 3c);
- iii. a first rolling head (7);
- iv. a second rolling head (5);
- v. a drive (4) associated with the rolling arm (3) for shifting the first and second rolling heads relative to one another between an open and closed position.

8. Regarding claim 2, Hamada discloses that the first rolling head is fixed to arm (3) and that the second rolling head is movable rectilinearly along the rolling arm (see Fig. 1b).

9. Regarding claim 3 and 6, inherent between the driving piston 4 and the arm portion 3a are “slide surfaces” or “guide surfaces.”

10. Regarding claims 4 and 7, Hamada discloses that the drive (4) is a fluid hydraulic cylinder mounted on the arm (3) and connected to the second rolling head (5).

11. Regarding claim 8, Hamada discloses that the arm support (2,3c) comprises a lever (3c) which pivots about stand (2). Given that Hamada’s device operates on only one journal at a time (see paragraph 17 and Fig. 1), an axial shift assembly is inherent.

12. Regarding claim 11, Hamada discloses that the rolling arm “is elongated” horizontally (see members 3a and 3b) and that “a portion” (3b) of the rolling arm is positioned behind the first rolling head (7).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada.

15. Regarding claim 5, it would have been an obvious matter of design choice to replace the hydraulic cylinder disclosed by Hamada with a "motor drive," since the applicant has not disclosed that using a "motor drive" instead of a hydraulic cylinder solves any stated problem or is for any particular purpose. A motor drive is a well-known mechanical expedient for a fluid pressure cylinder. Furthermore, it appears that the invention would perform equally well with a hydraulic cylinder.

16. Regarding claim 12, it would have been an obvious matter of design choice to place the hydraulic cylinder disclosed by Hamada on the other side of member 3a, since the applicant has not disclosed that such a configuration solves any stated problem or is for any particular purpose. Furthermore, it appears that the invention would perform equally well with the hydraulic cylinder placed as shown in Hamada's Fig. 1b.

17. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada in view of Garnett et al. (5,931,069 – hereinafter Garnett).

18. These claims add a counterweight mechanism for counterbalancing the arm. Garnett teaches, in the art of crankshaft turning machines, the use of a counterweight mechanism (186). Additionally, Garnett discloses that "[t]he weight of this counterweight counterbalances the

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unbalance caused during spindle rotation by the eccentric position of [the] housing" (column 5, lines 6-8). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Hamada's device with a counterweight mechanism in order to counterbalance the unbalance caused by the eccentric rotation of the arm 3, as suggested by Garnett.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Goetz whose telephone number is 703-308-1411. The examiner can normally be reached on Mon, Tues, Thurs, Fri 7:00am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen Ostrager can be reached on 703-308-3136. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3136.

JSG
September 29, 2003


ALLEN OSTRAGER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700